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EPW

PTO/SB/64 (09-04)  
Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)  
286357-00004-1

First named inventor: PAOLO TIRAMANI

Application No.: 10/653,523

Art Unit: 3637

Filed: September 2, 2003

Examiner:

Title: Modular prefabricated house

Attention: Office of Petitions

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**

☒ Small entity-fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ \_\_\_\_\_ (37 CFR 1.17(m))

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in the form of \_\_\_\_\_ (identify type of reply):

- ☐ has been filed previously on \_\_\_\_\_  
☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ \_\_\_\_\_.

- ☐ has been paid previously on \_\_\_\_\_  
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

09/01/2005 SFELEKE1 00000009 10653523

750.00 DP

01 FC:2453

## 3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

<p>_____ Signature</p> <p>_____ David C. Jenkins Typed or printed name</p> <p>_____ 600 Grant Street, 44th Floor Address</p> <p>_____ Pittsburgh, PA 15219 Address</p>	<p>_____ August 26, 2005 Date</p> <p>_____ 42,691 Registration Number, if applicable</p> <p>_____ 412/566-1253 Telephone Number</p>
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Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☒ Other: Request for Clarification and Precautionary Petition to Revive

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (703) 872-9306.

\_\_\_\_\_  
August 26, 2005  
Date

\_\_\_\_\_  
Signature

\_\_\_\_\_  
David C. Jenkins  
Typed or printed name of person signing certificate



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 3637 )  
In re Application of: ) MODULAR PREFABRICATED HOUSE  
PAOLO TIRAMANI )  
Serial No. 10/653,523 ) Attorney Docket No. 286357-00004-1  
Filed September 2, 2003 )

**REQUEST FOR CLARIFICATION AND PRECAUTIONARY  
PETITION TO REVIVE**

August 26, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant request clarification as to whether a non-publication request must be rescinded when an application addressed to similar subject matter is filed in Canada. Applicant notes the following:

1. On September 2, 2003 Applicant filed the present application and a non-publication request. This application claimed priority from provisional application 60/407,046, filed on August 30, 2002.
2. On September 24, 2003, more than one year after the filing date of the provisional application identified above, Applicant filed a Canadian patent application, Canadian Patent Application No. 2,442,403, addressing a similar invention as in the present U.S. Patent Application.
3. Applicant has just recently become aware that the non-publication request was not rescinded.

4. 35 U.S.C. §122(b)(2)(B)(i) and 35 U.S.C. §122(b)(2)(B)(iii) provide in pertinent part:

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that **requires publication** of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

...

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or **under a multilateral international agreement specified in clause (i)**, an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application.

(emphasis added)

Thus, an applicant who has filed a non-publication request is only required to notify the Director when a subsequent application is filed in a country that *requires* publication after 18 months.

5. A “Patent Publication” in the United States is defined in 37 C.F.R. §1.215, which states:

The publication of an application under 35 U.S.C. 122 (b) shall include a patent application publication.

The date of publication shall be indicated on the patent application publication.

As such, a “publication of an application” requires the printing of a separate document, the “patent application publication.”

6. In Canada, however, a patent application is not “published” after 18 months. Instead, Canadian law provides that “patents, applications for patents and documents filed in connection with patents or applications for patents shall be open to public inspection at the Patent Office” after 18 months. *See*, R.S., 1985, c. P-4, s. 10; R.S., 1985, c. 33 (3rd Supp.), s. 2; 1993, c. 15, s. 28. *See also*, <http://laws.justice.gc.ca/en/P-4/91746.html#rid-91794>

7. Canadian law further provides for “publication” of patent applications and states that:

The Commissioner **may** publish any document open to the inspection of the public under section 10 and may print or cause to be printed, for distribution or sale, any such document.

R.S., 1985, c. 33 (3rd Supp.), s. 7. (emphasis added)

Therefore, under Canadian law “publication” is discretionary and not required.

Accordingly, Applicant requests clarification as to whether the filing of the Canadian application required Applicant to rescind the non-publication request in the present application given that (1) U.S. law states that a non-publication request must only be rescinded if a subsequent application is filed in a country that *requires* publication, and (2) in Canada a publication is *optional*.

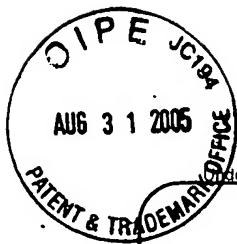
As a precaution, Applicant has further submitted the attached Petition to Revive in the event the Director finds that the optional publication in Canada satisfies the requirement of 35 U.S.C. §122(b)(2)(B)(i) and 35 U.S.C. §122(b)(2)(B)(iii) relating to required publications.

Respectfully submitted,



David C. Jenkins  
Registration No. 42,691  
Eckert Seamans Cherin & Mellott, LLC  
600 Grant Street, 44th Floor  
Pittsburgh, PA 15219  
Attorney for Applicant

(412) 566-1253



PTO/SB/21 (02-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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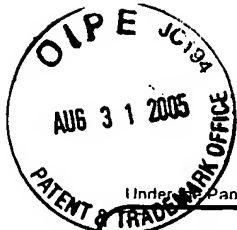
<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/653,523
	Filing Date	09/02/2003
	First Named Inventor	Paolo Tiramani
	Art Unit	3637
	Examiner Name	
Total Number of Pages in This Submission	Attorney Docket Number	286357-00004-1

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	Return Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	Request for Clarification and Precautionary
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	Petition to Revive
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	Rescission of Nonpublication Request
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>		
Firm or Individual name	David C. Jenkins Eckert Seamans Cherin & Mellott, LLC	
Signature		
Date	August 26, 2005	

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	David C. Jenkins		
Signature		Date	August 26, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL

## For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 750.00)

**Complete if Known**

Application Number	10/653,523
Filing Date	09/02/2003
First Named Inventor	Paolo Tiramani
Examiner Name	
Art Unit	3637
Attorney Docket No.	286357-00004-1

**METHOD OF PAYMENT** (check all that apply)☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 02-2556 Deposit Account Name: Eckert Seamans Cherin & Mellott

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 20 or HP = _____ x _____ = _____						
HP = highest number of total claims paid for, if greater than 20						
<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>			
- 3 or HP = _____ x _____ = _____						
HP = highest number of independent claims paid for, if greater than 3						

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other: Petition to Revive Unintentionally

750.00

**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent) 42,691	Telephone 412/566-1253
Name (Print/Type)	David C. Jenkins	Date August 26, 2005	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESCISSION OF PREVIOUS NONPUBLICATION  
REQUEST**

(35 U.S.C. 122(b)(2)(B)(ii))  
**AND, IF APPLICABLE,  
NOTICE OF FOREIGN FILING**  
(35 U.S.C. 122(b)(2)(B)(iii))

Send completed form to:  
**Mail Stop PG Pub**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
FAX: (703) 305-8568

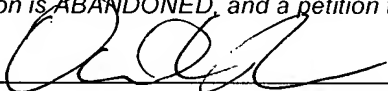
Application Number	10/653,523
Filing Date	9/2/2003
First Named Inventor	Paolo Tiramani
Title	MODULAR PREFABRICATED HOUSE
Atty Docket Number	286357-00004-1
Art Unit	3637
Examiner	

A request that the above-identified application not be published under 35 U.S.C. 122(b) (nonpublication request) was included with the above-identified application on filing pursuant to 35 U.S.C. 122(b)(2)(B)(i).

I hereby **rescind** the previous nonpublication request.

If a notice of foreign or international filing is or will be required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c), I hereby provide such notice. This notice is being provided no later than forty-five (45) days after the date of such foreign or international filing.

*If a notice of subsequent foreign or international filing required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was not filed within forty-five (45) days after the date of filing of the foreign or international application, the application is **ABANDONED**, and a petition to revive under 37 CFR 1.137(b) is required. See 37 CFR 1.137(f).*

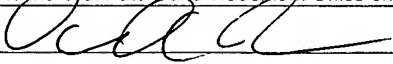
	August 26, 2005
Signature	Date
David C. Jenkins	42,691
Typed or printed name	Registration Number, if applicable
412/566-1253	
Telephone Number	

**This request must be signed in compliance with 37 CFR 1.33(b).**

If information or assistance is needed in completing this form, please contact the Pre-Grant Publication Division at (703)605-4283 or by e-mail at [PGPub@USPTO.gov](mailto:PGPub@USPTO.gov).

**CERTIFICATE OF MAILING OR TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop PG Pub, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature 	
Name (Print/Type) David C. Jenkins	Date August 26, 2005

This collection of information is required by 37 CFR 1.213(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PG Pub, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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